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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/265,788 03/10/99 LU R 08291/482001

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IM22/0407

EXAMINER

GARRETT, D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 04/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/265,788

Applicant(s)
Lu et al.

Examiner
Dawn Garrett

Group Art Unit
1774



☒ Responsive to communication(s) filed on 1-13-00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 4-9, and 11-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-9, and 11-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment, paper no. 6, dated January 13, 2000. Claims 3 and 10 have been canceled.
2. The text of those sections of Title 35, U.S. Code, not included in this action, can be found in the first Office action, paper no. 4, mailed October 14, 1999.
3. The objections set forth in paper no. 4, paragraph 2 are withdrawn.
4. Claims 10-12 (note: the second occurring claims 10-11) are objected to because of the following informalities: There are two claims numbered as claim 10 and two claims numbered as claim 11. Misnumbered claims 10-12 (note: the second occurrence of numbers 10 and 11) have been renumbered 12-14.
5. Claims 11 and 12 (renumbered claims 13 and 14) are again rejected under 35 U.S.C. 112, second paragraph, due to the phrase "effective amount". In these claims the intended effect is not defined.
6. Claim 1 is again rejected under 35 U.S.C. 112, second paragraph, for the reasons set forth in paper no. 4, paragraph 5.
7. The rejection of claims 3-5 under 35 U.S.C. 112, second paragraph, as set forth in paper no. 4, paragraph 6 is withdrawn.

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8. Claims 1 and 7 are again rejected under 35 U.S.C. 112, second paragraph, for the reasons set forth in paper no. 4, paragraph 7.

9. The rejection of claims 1-2 under 35 U.S.C. 102(b) as being anticipated by Malik (US H269) is withdrawn.

10. All pending claims are again rejected under 35 U.S.C. 103(a) as being unpatentable over Richter (US 5,728,667).

Claim Rejections - 35 USC § 112

11. The following rejection is necessitated by amendment:

Claims 4, 5, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 depend upon canceled claim 3. Claim 11 depends upon canceled claim

10. Correction of the dependencies of claims 4, 5, and 11 is required.

Response to Arguments

12. Applicant's arguments filed January 13, 2000 have been fully considered but they are not persuasive. With regard to applicant's statements regarding the phrase "effective amount", it is noted that the 112 rejection has been maintained only over the claims which do not recite the intended effect. Applicant's arguments regarding the Malik reference are considered moot in view of the withdrawal of the rejection over Malik (US H269). In regard to the Richter reference, applicant argues a glycoside surfactant is not described as being essential to the

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Richter compositions. The examiner submits Richter teaches “the nonionic surfactant can be present either singly, or as a mixture of two or more nonionic surfactant compounds...” (see col. 10, lines 63-65). Glycosides are clearly taught as suitable nonionic surfactants (see col. 9, lines 54-58). Applicant also argues “nowhere in the Richter specification is there any teaching or any suggestion...as to which of the myriad surfactants described in Richter would be properly selected in order to provide a useful mitigating effect to the quaternary ammonium compound.”

In response, Richter clearly teaches all the surfactant limitations of the instant claims. Applicant has not provided data showing unexpected results in contrast to the teachings of Richter. Please note the following: a showing of unexpected results must compare to the closest prior art (see *Ex parte Beck*, 9 USPQ 2d 2000 (BPAI 1987); *In re Burkel*, 201 USPQ 67 (CCPA 1979); *In re Merchant*, 197 USPQ 785 (CCPA 1976)) and furthermore, evidence of unobviousness must be commensurate in scope with the claims (see *In re Kulling*, 14 USPQ 2d 1056, 1058 (Fed. Cir. 1990); *In re Clemens*, 206 USPQ 289 (CCPA 1980); *In re Dill*, 202 USPQ 805, 808 (CCPA 1979); *In re Greenfield*, 197 USPQ 227 (CCPA 1978)). Applicants’ arguments regarding the technical effects of the Richter compositions and the Tables presented by Richter have been considered, but are insufficient to overcome the rejection. It is respectfully noted non-preferred embodiments can be indicative of obviousness (see *In re Lamberti*, 192 USPQ 278 (CCPA 1976); *In re Boe*, 148 USPQ 507 (CCPA 1976); *In re Kohler*, 177 USPQ 399 (CCPA 1973)). Accordingly, it is respectfully maintained that the examiner has established a proper case of *prima facie* obviousness against the instant claims.

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Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Should you have any questions concerning this communication, please direct them to Dawn Garrett at 703-305-0788. The examiner can be reached at this number from about 8:00 am to about 5:00 pm E.S.T. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, William Krynski, can be reached at 703-308-2376. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza
3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1700 are 703-305-3599 for official after-final faxes, and 703-305-5408 for all other

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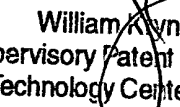
official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-2351.



D.G

March 29, 2000



William Kivinski
Supervisory Patent Examiner
Technology Center 1700